

constraining, not elastic properties. *See* Nissing, SUMMARY OF THE INVENTION, column 2, lines 3-7; DETAILED DESCRIPTION OF THE INVENTION, column 7, lines 20-22. There is no extrinsic evidence to suggest that Nissing's film layer would inherently have some degree of elasticity.

According to *In re Gordon*, if the "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." 733 F.2d 900 (Fed. Cir. 1984); MPEP § 2143.01 V. Nissing teaches "a plastic film layer which is less extensible when wetted than the first layer." *See* Nissing, SUMMARY OF THE INVENTION, column 1, lines 66-67. Applicants teach the use of an "elastic film." *See* paragraph [0017] of the specification as originally filed. American Heritage Dictionary defines elastic as "easily resuming original shape after being stretched or expanded; flexible." *See* Elastic, *The American Heritage Dictionary of the English Language*, 4<sup>th</sup> ed., Houghton Mifflin Company, 2004. In contrast, extensible is defined as "capable of being extended or protruded." *See* Extensible, *The American Heritage Dictionary of the English Language*, 4<sup>th</sup> ed., Houghton Mifflin Company, 2004. As shown by these definitions, a material can be extensible without being elastic. Applicants' use of an elastic film is necessary for the purpose of the invention, which is "to assure a comfortable fit" for absorbent articles. *See* paragraph [0003] of the specification as originally filed. Nissing does not teach the use of an elastic film because the use of an elastic would thwart the film layer's function to "constrain[s] extension of the first layer...as a result, the first layer deforms." *See* Nissing, SUMMARY OF THE INVENTION, column 2, lines 3-5. The deformation of the first layer due to constraint by the film layer in Nissing is essential to the purpose of the cited prior art: to "increase the wet texture, wet caliper (thickness) and wet bulk of the wipe." *See* Nissing,

DETAILED DESCRIPTION OF THE INVENTION, column 5, lines 16-17. If the second layer in Nissing was modified to elastic, the second layer could not constrain the extension of the first layer, and thus the first layer would not deform, rendering the prior art invention unsatisfactory for its intended purpose as a disposable wiping article.

When a suggested modification “would require a substantial reconstruction and redesign of the elements...as well as a change in the basic principle under which the primary reference construction was designed to operate,” the teaching of the references [is] not sufficient to render the claims *prima facie* obvious. *See In re Ratti*, 270 F.2d 810, 813 (CCPA 1959); MPEP § 2143.01 VI. Applicants’ claimed invention operates under the basic principle of encouraging elasticity—so that the creped layer can be stretched smooth, allowing the absorbent articles to maintain a close and comfortable fit to the body. *See* paragraphs [0003], [0018]-[0019] of the specification as originally filed. The cited prior art operates under the basic principle of restricting elasticity. The film layer “constrains” the first layer so that instead of allowing the creped material to stretch smooth, the first layer deforms, exaggerating the creped effect “by buckling or puckering, in the Z-direction (perpendicular to the plane of the first layer).” *See* Nissing, SUMMARY OF THE INVENTION, column 2, lines 3-7. The first layer’s deformation and Z-direction expansion illustrates Nissing’s basic principle of operation: “to *increase* texture upon wetting.” *See* Nissing, BACKGROUND OF THE INVENTION, column 1, lines 23-24 (emphasis added). The increase in texture allows Nissing’s wipe to act as a sponge by the “generation of foam, suds, or lather” and the “entrapment of dirt, grime, and the like.” *See* Nissing, BACKGROUND OF THE INVENTION, column 1, lines 50-56. Modifying Nissing’s film layer to become elastic would prevent deformation of the first layer, frustrating the cited prior art’s basic principle of operation. The modification would require substantial redesign and

reconstruction of the elements in order to achieve an increase in texture upon wetting, therefore the modification cannot be used to find Applicants' claimed invention *prima facie* obvious.